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Atty. Dkt. No. YOR92001013PUS

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REMARKS

In view of the following discussion, the Applicants submit that none of the claims now pending in the application are indefinite under the provisions of 35 U.S.C. §112, anticipated under the provisions of 35 U.S.C. §102 or obvious under the provisions of 35 U.S.C. §103. Thus, the Applicants believe that all of the presented claims are in condition for allowance.

I. REJECTION OF CLAIMS 1 AND 10 UNDER 35 U.S.C. § 112

The Examiner rejected claims 1 and 10 under 35 U.S.C. §112, second paragraph, for allegedly failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. In response, the Applicants have amended claims 1 and 10 in order to more clearly recite aspects of the present invention.

In particular, claim 1 has been amended to recite, "... each of the plurality of parties having at least one computing system ...", replacing "... each having at least one computing system ...". Claim 10 has been amended to recite, a publicly defined template that is "an electronic commerce business-to-business purchasing standard", replacing a publicly defined template that is "Open Buying on the Internet".

In light of the above amendments, the Applicants respectfully request that the rejection of claims 1 and 10 under 35 U.S.C. §112, second paragraph be withdrawn.

II. REJECTION OF CLAIMS 1-6, 8, 9, 12-17 AND 22-34 UNDER 35 U.S.C. § 102

The Examiner rejected claims 1-6, 8, 9, 12-17 and 22-34 as being anticipated under 35 U.S.C. §102(a) by the Su et al. article ("A Replicable Web-Based Negotiation Server For E-Commerce", hereinafter "Su"). In response, the Applicants have amended independent claims 1, 8, 12, 15, 28, 30, 31, 33 and 34, from which claims 2-6, 9, 13-14, 16-17, 22-27, 29 and 32 depend, in order to more clearly recite aspects of the present invention.

The Examiner's attention is respectfully directed to the fact that Su fails to teach or suggest the novel invention of establishing a common negotiation protocol or specification of machine-executable rules for use by negotiating parties prior to a

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negotiation, as recited in Applicants' amended independent claims 1, 8, 12, 15, 28, 30, 31, 33 and 34.

By contrast, Su teaches that each party to a negotiation specifies its own set of negotiation rules prior to a negotiation taking place. A third-party negotiation server then attempts to reconcile the negotiation rules of the individual parties by evaluating proposals and generating counter-proposals, messages and explanations (See, e.g., Su, page 4, column 2: "[A]n important part of the registration procedure is the specification of negotiation strategies to be used by the negotiation server on behalf of its client", emphasis added). Thus, the parties do not agree on a common negotiation protocol prior to entering the negotiation, as recited by Applicants' claims 1, 8, 12, 15, 28, 30, 31, 33 and 34. Specifically, Applicants' claims 1, 8, 12, 15, 28, 30, 31, 33 and 34 positively recite:

1. A method for automating contract negotiation between a plurality of parties, each of the plurality of parties having at least one computing system coupled to a communications network and one or more applications running thereon, the method comprising the steps of:

establishing a common negotiation protocol that specifies negotiation operations, the negotiation protocol being agreed upon by the plurality of parties prior to the contract negotiation;

forming a negotiation meta contract to control the contract negotiation, in accordance with the negotiation protocol;

communicating a request to negotiate; and

conducting an automatic negotiation, according to the negotiation meta contract, between the one or more applications of each of the plurality of parties. (Emphasis added)

8. A method for conducting a negotiation between a plurality of parties, each of said parties having a computer system coupled to a communication network and one or more applications running thereon, the method comprising the steps of:

providing a specification of machine-executable rules of negotiation for the parties for generating at least one contract, the specification being agreed upon by the plurality of parties prior to conducting the negotiation; and

providing a starting state for a contract in accordance with the specification, wherein the starting state is selectable from one of: a previous contract, a publicly defined template, and a template defined prior to the negotiation by one of the parties. (Emphasis added)

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12. A method for conducting an automatic negotiation between a plurality of parties, each of said parties having a computer system coupled to a communication network and one or more applications running thereon, the method comprising the steps of:

establishing a common negotiation protocol that specifies negotiation operations, the negotiation protocol being agreed upon by the plurality of parties prior to the negotiation;

creating a template prior to the negotiation in accordance with the negotiation protocol, wherein the template contains business logic for performing a negotiation electronically;

registering the business logic, prior to the negotiation, with a server accessible by one or more parties; and

implementing the business logic in a negotiation conducted automatically between computer systems over the communication network. (Emphasis added)

15. A method for conducting a negotiation between a plurality of parties, each of said parties having a server coupled to a communication network and one or more applications running thereon, comprising the steps of:

providing a specification of machine-executable rules of negotiation for the parties for generating at least one contract, the specification being agreed upon by the plurality of parties prior to conducting the negotiation;

enabling an automatic negotiation to take place between the servers in accordance with the specification of machine-executable rules; and

forming a meta contract for controlling a negotiation process in accordance with the specification. (Emphasis added)

28. A method for conducting a negotiation between a plurality of parties, each of said parties having a computer system coupled to a communication network and one or more applications running thereon, comprising the steps of:

providing a specification of machine-executable rules of negotiation for the parties for generating at least one contract, the specification being agreed upon by the plurality of parties prior to conducting the negotiation;

forming a meta contract to control the negotiation, in accordance with the specification; and

enabling an automatic negotiation to take place between the parties in accordance with the specification of machine-executable rules;

wherein at least one of the negotiating parties is an intermediary for facilitating the automatic negotiation. (Emphasis added)

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30. A computer program product in a computer readable medium in a first computer system for conducting a negotiation between a plurality of parties, comprising:

first instructions for providing a specification of machine-executable rules of negotiation for the parties for generating at least one contract, the specification being agreed upon by the plurality of parties prior to conducting the negotiation;

second instructions for enabling an automatic negotiation to take place between a party located at the first computer system and a party located at a second computer system in accordance with the specification of machine-executable rules; and

third instructions for negotiating a contract automatically between the parties. (Emphasis added)

31. A method of conducting a negotiation over a data communication network between a service provider and a service requester, comprising the steps of:

establishing, by the service provider and the service requester, a common negotiation protocol that specifies negotiation operations, the negotiation protocol being agreed upon by the service provider and the service requester prior to the contract negotiation;

providing, by the service provider, a negotiation meta-contract to control the negotiation, in accordance with the negotiation protocol;

receiving, at the service provider, a request to negotiate from the service requester;

responsive to the request to negotiate, automatically negotiating with the service requester by the service provider in accordance with the negotiation meta-contract. (Emphasis added)

33. A method of conducting business over the Internet, wherein parties negotiate contractual terms between two data communication network components, the method comprising the steps of:

providing a specification of machine-executable rules of negotiation for generating at least one contract, the specification being agreed upon by the parties prior to negotiating the contractual terms;

forming a meta contract to control the negotiating, in accordance with the specification; and

originating a negotiation at a first party in accordance with the rules of negotiation. (Emphasis added)

34. An article of manufacture for automating contract negotiation between a plurality of parties, comprising a machine readable medium containing one or more programs which when executed implement the steps of:

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communicating, in a preliminary step, a common negotiation protocol that specifies negotiation operations, the negotiation protocol being agreed upon by the plurality of parties prior to the contract negotiation;

communicating a request to negotiate; and

conducting an automatic negotiation, according to the negotiation protocol, between the one or more applications of each of the plurality of parties.
(Emphasis added)

Since Su does not teach or suggest establishing a common negotiation protocol or specification of machine-executable rules for use by negotiating parties prior to a negotiation, Su does not teach each and every element of Applicants' amended independent claims 1, 8, 12, 15, 28, 30, 31, 33 and 34. Moreover, dependent claims 2-6, 9, 13-14, 16-17, 22-27, 29 and 32 depend, either directly or indirectly, from independent claims 1, 8, 12, 15, 28, 30, 31, 33 and 34 and recite additional features. As such, and for at least the exact same reason set forth above, the Applicants submit that claims 2-6, 9, 13-14, 16-17, 22-27, 29 and 32 are also not anticipated and are allowable.

Therefore, Applicants contend that claims 1-6, 8, 9, 12-17 and 22-34 are patentable over Su and, as such, fully satisfy the requirements of 35 U.S.C. §102. Thus, Applicants respectfully request that the rejection of claims 1-6, 8, 9, 12-17 and 22-34 under 35 U.S.C. §102 be withdrawn.

III. REJECTION OF CLAIMS 1-5, 7-9 AND 11-34 UNDER 35 U.S.C. § 103

A. Claims 18-21

The Examiner rejected claims 18-21 as being unpatentable under 35 U.S.C. §103(a) over Su. In response, the Applicants have amended independent claim 15, from which claims 18-21 depend, as discussed above in order to more clearly recite aspects of the present invention.

As discussed above, Su fails to teach or suggest the novel invention of establishing a common negotiation protocol or specification of machine-executable rules for use by negotiating parties prior to a negotiation, as recited in Applicants' amended independent claim 15. Thus, Su does not teach each and every element of Applicants' claim 15. Moreover, dependent claims 18-21 depend, either directly or indirectly, from

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independent claim 15 and recite additional features. As such, and for at least the exact same reason set forth above, the Applicants submit that claims 18-21 are also not made obvious and are allowable.

Therefore, Applicants contend that claims 18-21 are patentable over Su and, as such, fully satisfy the requirements of 35 U.S.C. §103. Thus, Applicants respectfully request that the rejection of claims 18-21 under 35 U.S.C. §103 be withdrawn.

B. Claim 24

The Examiner rejected claim 24 as being unpatentable under 35 U.S.C. §103(a) over the Walker et al. patent (United States Patent No. 5,794,207, issued August 11, 1998, hereinafter "Walker"). In response, the Applicants have amended independent claim 15, from which claim 24 depends, as discussed above in order to more clearly recite aspects of the present invention.

The Examiner's attention is respectfully directed to the fact that Walker fails to teach or suggest the novel invention of establishing a common negotiation protocol or specification of machine-executable rules for use by negotiating parties prior to a negotiation, as recited in Applicants' amended independent claim 15.

By contrast, Walker teaches presenting a binding purchase offer from a prospective buyer to a plurality of potential sellers. Acceptance by a seller binds the buyer to the purchase offer. Thus, there is no agreement between the buyer and seller as to a negotiation protocol prior to the negotiation – a seller simply chooses whether or not to accept an offer that is unilaterally dictated by the buyer.

Accordingly, Walker fails to teach or suggest establishing a common negotiation protocol or specification of machine-executable rules for use by negotiating parties prior to a negotiation, as recited in Applicants' amended independent claim. Thus, Walker does not teach each and every element of Applicants' claim 15. Moreover, dependent claim 24 depends from independent claim 15 and recites additional features. As such, and for at least the exact same reason set forth above, the Applicants submit that claim 24 is also not made obvious and is allowable.

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Moreover, Applicants affirmatively traverse the Examiner's use of Official Notice. It is respectfully submitted that the Examiner provides the necessary support for the use of Official Notice.

Therefore, Applicants contend that claim 24 is patentable over Walker and, as such, fully satisfies the requirements of 35 U.S.C. §103. Thus, Applicants respectfully request that the rejection of claim 24 under 35 U.S.C. §103 be withdrawn.

C. Claims 1-5, 7-9, 11-17, 22, 23 and 25-34

The Examiner rejected claims 1-5, 7-9, 11-17, 22, 23 and 25-34 as being unpatentable under 35 U.S.C. §103(a) over Walker in view of the Robinson et al. article ("Supporting the Negotiation Life Cycle", hereinafter "Robinson"). In response, the Applicants have amended independent claims 1, 8, 12, 15, 28, 30, 31, 33 and 34, from which claims 2-5, 7, 9, 11, 13-14, 16-17, 22, 23, 25-27, 29 and 32 depend, as discussed above in order to more clearly recite aspects of the present invention.

As discussed above, Walker fails to teach or suggest the novel invention of establishing a common negotiation protocol or specification of machine-executable rules for use by negotiating parties prior to a negotiation, as recited in Applicants' amended independent claims 1, 8, 12, 15, 28, 30, 31, 33 and 34. Robinson fails to bridge this gap in the teachings of Walker. By contrast, Robinson simply proposes a framework of the negotiation life cycle and identifies existing tools and techniques that support various phases of the cycle.

Thus, Walker in view of Robinson does not teach each and every element of Applicants' claims 1, 8, 12, 15, 28, 30, 31, 33 and 34. Moreover, dependent claims 2-5, 7, 9, 11, 13-14, 16-17, 22, 23, 25-27, 29 and 32 depend, either directly or indirectly, from independent claims 1, 8, 12, 15, 28, 30, 31, 33 and 34 and recite additional features. As such, and for at least the exact same reason set forth above, the Applicants submit that claims 2-5, 7, 9, 11, 13-14, 16-17, 22, 23, 25-27, 29 and 32 are also not made obvious and are allowable.

Therefore, Applicants contend that claims 1-5, 7-9, 11-17, 22, 23 and 25-34 are patentable over Walker in view of Robinson and, as such, fully satisfy the requirements

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of 35 U.S.C. §103. Thus, Applicants respectfully request that the rejection of claims 1-5, 7-9, 11-17, 22, 23 and 25-34 under 35 U.S.C. §103 be withdrawn.

IV. CONCLUSION

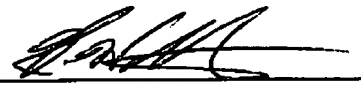
Thus, the Applicants submit that all of the presented claims fully satisfy the requirements of 35 U.S.C. §112, 35 U.S.C. §102 and 35 U.S.C. §103. Consequently, the Applicants believe that all of these claims are presently in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring the issuance of a final action in any of the claims now pending in the application, it is requested that the Examiner telephone Mr. Kin-Wah Tong, Esq. at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

11/13/06

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